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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,873	12/21/2000	Junichi Kakutani	001558	6102

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EXAMINER

CONE, DARIUS N

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/740,873

Applicant(s)

KAKUTANI, JUNICHI

Examiner

Darius N. Cone

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, the apparatus used for registering paper information is an alternative table to what? Is there an initial table where information is stored?

Claim 2, recites the limitation "the indication" in lines 15 and 16. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the indication" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the registered content" in line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the plurality of pieces of paper information" in line 17. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara (US pat # 6,024,505) in view of Umezawa et al. (US pat # 4,725,869).

With respect to claim 1, Shinohara teaches a plurality of host devices 3 in bi-directional communication with printer 1 containing an alternative table or memory 23 for accepting registered paper information from a transmission unit 35, which includes at least a paper size or a paper type according to an indication from a host device 3 input by a user. While Shinohara teaches, a printing system capable of registering paper information in memory according to input from a user, there is no teaching of tray selection unit for selecting the tray corresponding to the printing job assigned by the operator. Umezawa et al. teach tray selection unit 5, which selects a tray corresponding to the print job registered in memory 6, when the print job data is not stored in any one of the plurality of trays. It would be obvious to one ordinary skilled in the art to modify the structure of Shinohara to include the tray selection capability of Umezawa et al. printer, allowing any unskilled operator to easily and exactly select a proper paper tray and avoid the loss of papers due to mis-operation in handling a machine with complicated functions.

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With respect to claim 2, Shinohara teaches control panel 27 receiving an indication when print controller 57 checks whether or not a desired sheet is a set for printing and whether a desired form sheet selected from memory 23 is actually selected according to the print job assigned (see col. 6, lines 11-32).

With respect to claims 3 and 4, while Shinohara teaches an alternative table for registering paper information, there is no teaching of a tray selection unit. Umezawa et al. teach a tray selection unit 5, which selects a tray specified by the print job based on an indication (paper information input by operator) (see col. 4, lines 9-34). It would be obvious to one ordinary skilled in the art to modify the structure of Shinohara to include a tray selection unit to select a tray specified by the print job based on the paper information input by the operator to assure correct paper type or size as requested by the print job so that a printing region does not protrude the paper size and normal printing is executed.

With respect to claims 5-8 and 10, while Shinohara teaches an alternative table for registering paper information, there is no teaching of registering the information for the tray specified by the print job since there is no tray selection unit taught by Shinohara. Umezawa et al. teach a print job input by the user detected by a transmission unit 3 for transmitting a confirmation from the control 4, a reception unit 5 receiving the confirmation notice, where after the reception of the confirmation notice, a paper stored in the tray selected is printed. According to an indication or error of the initial print job, changes can be made, registered in memory 6 and carried out, making it obvious to one ordinary skilled in the art to modify Shinohara to assure proper tray

selection and correct paper type or size selection, allowing the user to monitor normal printing execution as requested. (see col. 4, lines 13-35; col. 6, lines 6-28).

With respect to claim 7, while Shinohara teaches new a print job, which can be input by an operator, which register 33 stores in memory 23, over the previous print job, there is no teaching of a the trays containing the paper being changed and its contents being stored in memory, overriding the previous registered contents. Umezawa et al. teach judge circuit 5, which determines if a paper cassette has been properly selected for copying, conversely, if judge circuit 5, determines that the paper feed cassette is improper the cassette corresponding to the applicable print job is selected and stored in memory 6. It would be obvious to one ordinary skilled in the art to modify Shinohara to include the overriding capability of Umezawa et al. display device to register new information by clearing or overriding previous memory to ensure that the print information corresponds to the selected print job (see Umezawa et al, col. 4 , lines 13-34).

With respect to claim 9, Shinohara teaches a plurality of host computers 3, coupled to printer 1. In each host computer exists an alternative table or memory, which would be obvious to one ordinary skilled in the art to make easily accessible for the purpose of storing and retrieving information.

With respect to claim 11, Shinohara teaches a transmission unit 57 transmitting paper disagreement error information to the host when the print job data is not stored in any one of the plurality of trays and a reception unit 53 for receiving the indication from the host device 53. (col. 6, lines 11-32 and lines 33-48).


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With respect to claim 12, Shinohara teaches memory, which can be non-volatile memory or RAM (Random Access Memory) an obvious well known form of memory to one ordinary skilled in the art of printing for storing print information pertaining to paper size or type.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darius N. Cone whose telephone number is (703) 308-1061. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0725 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
ANDREW H. HIRSHFELD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2

DNC

October 1, 2002